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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,485	03/29/2001	Braj Bhushan Lohray	U013323-5	6450

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 10/21/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,485

Applicant(s)

LOHRAY ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5,11</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election of Group I claims 29-31 in Paper No. 12 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicants' cancellation of claims 32-33, in paper # 12, is also acknowledged.

Claims 29-31 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 29-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating diabetes complications, does not reasonably provide enablement for preventing diabetes related complications. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

In evaluating the enablement question, several factors are to be considered. Note In re Wands, 8 USPQ2d 1400 and Ex parte Forman, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence

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or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1) The nature of the invention:

The method of use claims 29-31 is drawn to besides treatment, prevention of any and all disorders due to complications of diabetes including those yet to be discovered. However, specification provides no support for preventing all or any disorders. In fact based on the specification and examples, it appears that the instant compounds are mainly PPAR and HMG CoA reductase inhibitors and may be useful for treating disorders of diabetes wherein these receptor are implicated. Specification has not provided any evidence or nexus that because of the mode of action of the instant compound, the compound would be useful for preventing all or any disorders arising from diabetes.

"To prevent" actually means to anticipate or counter in advance, to keep from happening etc. (as per Webster's II Dictionary) and therefore it is not understood how one skilled in the art can reasonably establish the basis and the type of subject to which the instant compounds can be administered in order to have the "prevention" effect. Further, there is no evidence on record which demonstrates that the in-vitro screening test relied upon is recognized in the art as being reasonably predictive of success in any of the contemplated areas of 'prevention'. Such a reasonable correlation is necessary to demonstrate such utilities. See *Ex parte Stevens*, 16 USPQ 2d 1379 (BPAI 1990); *Ex parte Busse*

et al., 1 USPQ 2d 1908 (BPAI 1986) (the evidence must be accepted as “showing” such utility, and not “warranting further study”).

The instant list of disorders includes conditions related diabetes, for which it is conventionally known that there is no cure or prevention (see e.g., http://www.hutcheson.org/Services/diabetes/index_diabetes.htm).

The evidence presented in this case does not show such utilities related to ‘prevention’, but only warrants further study.

2) The state of the prior art:

There are no known compounds of similar structure, which have been demonstrated shown to be useful for preventing all or any diseases due to diabetes. For example, the notion that a compound could be effective against all or any diseases because of its interaction with a single target, in the instant case HMG CoA reductase or PPAR, in general is absolutely contrary to our current understanding of pharmacological basis of drug design and treatment of diseases. In fact a specific target is often chosen to treat a specific disease or that specific target related diseases. Indeed, applicants’ instant claims 52-66 and 73-75 rely on this fact for treating disorders. Furthermore, the prior art search in the related area does not suggest that because of the mode of action of a compound, as PPAR receptor antagonist or HMG CoA reductase would be useful for preventing disorders.

3) The predictability or lack thereof in the art:

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As noted above, although there several prior art which teach similar compounds as PPAR receptor antagonist or HMG CoA reductase, they do not teach use of the compound disclosed for preventing any or all disorders of diabetes and hence there is no art predictability or assurance that instant compound would do so. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present:

Specification provides no guidance or direction, as to how would one use the instant compound to prevent all or any disorder of diabetes.

5) The presence or absence of working examples:

There are working examples to show that how the instant compound could be used to prevent disorders wherein PPAR receptor is implicated as causative agent or HMG CoA Reductase is implicated.

6) The breadth of the claim:

The breadth of the claim is broad enough to include prevention of any or all diseases including those yet to be discovered for which there is no pharmacological basis or showing in the specification.

7) The quantity of experimentation needed:

The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan for the many reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims 29-31.

References cited in the Information Disclosure Statement (paper # 4,5,11) are made of record.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Venkataraman Balasubramanian

10/19/2002